IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Brian A. Leete	Examiner: Christopher Lee
Serial No.:	09/730,238	Group Art Unit: 2112
Filed:	December 5, 2000	Docket: 884.335US1
Title:	POWER SUPPLY WITH BUS HUB	
Assignee:	Intel Corporation	Customer Number: 21186
Appeal No:	**2005-2753**	

REQUEST FOR REHEARING BY AN EXPANDED PANEL OF THE DECISION OF THE BOARD OF PATENT APPEALS AND INTERFERENCES IN ACCORDANCE WITH STANDARD OPERATING PROCEDURE 1 (REVISION 12)

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with 37 C.F.R. §41.52, the appellant hereby requests a rehearing by an expanded panel of the Decision of the Board of Patent Appeals and Interferences dated November 22, 2005 (Decision) in Appeal No. 2005-2753 affirming the Examiner. Section I below contains the grounds for an expanded panel. Section II contains the underlying grounds for a rehearing under §41.52.

I. Request for Expanded Panel – Standard Operating Procedure 1 (Revision 12)

The appellant respectfully requests a rehearing of the Decision by an expanded panel in accordance with Standard Operating Procedure 1 (Revision 12).[1] The appellant respectfully submits that the Decision raises the following issues of exceptional importance that justify review by an expanded panel.[2]

A. The appeal was from a rejection of claims under 35 U.S.C. §103. The appellant's brief cites Federal Circuit cases that are also cited in MPEP 2143 and 2144 as

[1] Standard Operating Procedure 1 (Revision 12), Section IV (C).
[2] Standard Operating Procedure 1 (Revision 12), Section IV (A)(1).

establishing the law of §103.[3] The Decision did not discuss or distinguish the appellant's Federal Circuit cases, but cited other case law in its analysis. All but one of the cases cited in the Decision are older than the Federal Circuit cases cited by the appellant. The appellant respectfully submits that the Decision did not address the more recent relevant case law of §103 cited by the appellant from MPEP 2143 and 2144.

B. The appellant's brief argued that the rejections did not cite evidence of a reasonable expectation of success. The MPEP states that a reasonable expectation of success is one of three elements of a *prima facie* case of obviousness.[4] The Federal Circuit in *In re Vaeck* established that a reasonable expectation of success must be found in the prior art.[5] The Decision does not discuss or support the element of a reasonable expectation of success, yet affirms the rejections under §103. The appellant respectfully submits that there are more elements of a *prima facie* case of obviousness set out in the MPEP and in *In re Vaeck* than are supported in the Decision.

II. Request for Rehearing

The appellant respectfully requests a rehearing of all grounds of rejection I-XIII listed in the appellant's brief. The appellant respectfully submits that the Decision misapprehended or overlooked the following points set out in the appellant's brief:

A. The appellant's brief cited Federal Circuit cases *In re Zurko, In re Vaeck, In re Lee, In re Dembiczak, In re Rouffet, and In re Kotzab* in support of the appellant's arguments. The Decision did not discuss any of these cases, but provided another list of cases to support its analysis. All but one of the cases listed in the Decision are older than the Federal Circuit cases cited in the appellant's brief. In addition, all of the Federal Circuit cases cited by the appellant are also cited in MPEP 2143 and 2144 as establishing

[3] Specifically, the appellant cited *In re Zurko, In re Vaeck, In re Lee, In re Dembiczak, In re Rouffet, and In re Kotzab.*
[4] MPEP 2143.
[5] *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

the law of §103. The appellant respectfully submits that the Decision overlooked the more recent Federal Circuit case law cited in the appellant's brief and in MPEP 2143 and 2144.

B. The appellant's brief argued that the rejections did not cite evidence of a reasonable expectation of success. The MPEP states that a reasonable expectation of success is one of three elements of a *prima facie* case of obviousness.[6] The Decision does not discuss or support the element of a reasonable expectation of success. The Federal Circuit has stated that all elements of a *prima facie* case of obviousness must be established in a rejection:

> "Omission of a relevant factor required by precedent is both legal error and arbitrary agency action." [7]

The appellant respectfully submits that the Decision overlooked the element of a reasonable expectation of success in affirming the rejections under §103.

C. The appellant's brief set out 13 different grounds of rejection (I-XIII) to be reviewed on appeal. The Decision addressed only grounds I-VI separately. Grounds VII-XIII were not addressed individually in the Decision, but were dismissed in a single paragraph.[8] The appellant respectfully submits that the Decision overlooked the necessity of identifying a *prima facie* case of obviousness for each of the different grounds of rejection VII-XIII. The initial pages of appellant's brief referred to each separate ground of rejection I-XIII when stating that "the rejections of claims 1-23 and 26-48 under §103 are improperly based on hindsight as the final Office Action has not provided clear and particular evidence of a suggestion or motivation to form the proposed combinations from the applied references."[9]

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[6] MPEP 2143.
[7] *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).
[8] Decision, page 14.

D. The Decision has misapprehended the appellant's argument that there is no clear and particular evidence of a suggestion or motivation to form the proposed combinations from the applied references.

The Decision states that "[o]ne skilled in the art....would have quickly come to realize that" the combination of Flannery and Herwig would have been "convenient" without supporting evidence from the prior art.[10] Other similar statements about what one skilled in the art would have done are found on pages 8-9 without supporting citations from the prior art. The appellant respectfully submits that these are new statements of motivation for combining the references not found in the rejections from the Examiner or in the prior art, and that none of the prior art suggests that the combination would be "convenient."

With regard to the rejections based on Flannery and Herwig combined with one or more other references, the Decision does not identify evidence of any additional suggestions or motivation in the prior art to make the augmented combinations. The appellant argued that each different combination of references was not supported by evidence from the prior art. The Federal Circuit cases cited by the appellant require that each addition of a new reference to a combination must be supported by a separate suggestion or motivation. The Decision has not shown evidence from the prior art of a separate suggestion or motivation to add each supplemental reference to the original Flannery and Herwig combination.

The Decision states that the "appellants have shown no error in the examiner's rationale for combining the references."[11] *In re Vaeck* requires that a suggestion or motivation for combining references under §103 come from the prior art, not from the examiner. The examiner's rationale is hindsight which cannot be used to support a rejection under §103.

On page 13, the Decision states that "appellants merely argue generally that the examiner has 'not cited clear and particular evidence of record in support of a motivation

[9] Appellant's Brief, page 10.
[10] Decision, page 8.
[11] Decision, page 14.

to combine.'"[12] Clear and particular evidence from the prior art of a suggestion or motivation is what is required collectively by *In re Zurko, In re Vaeck, In re Lee, In re Dembiczak, In re Rouffet,* and *In re Kotzab,* cases not considered in the Decision. The appellant respectfully submits that the Decision has misapprehended the appellant's argument.

The appellant respectfully submits that a rehearing should be granted under 37 C.F.R. § 41.52.

III. Conclusion

The appellant respectfully submits that the rejections of claims 1-23 and 26-48 under 35 U.S.C. §103 were erroneous. Reversal of those rejections is respectfully requested, as well as the allowance of all the rejected claims.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 20 JANUARY 2006 By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20th day of January, 2006.

Name Amy Moriarty

Signature _____

[12] Decision, page 13.